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In re Application of :
FOLLESTAD et al. :
Application No. 09/601,652 :
PCT No.: PCT/NO99/00043 : DECISION ON PETITION
Int. Filing Date: 09 February 1999 :
Priority Date: 09 February 1998 :
Attorney Docket No.: 09100.017 :
For: METHOD FOR PREPARATION :
THEREOF :

This is a response to applicants' "Completion of Filing Requirements" filed 22 January 2001 which is being treated as Petition under 37 CFR 1.42 and "Petition to Reinstate Application" filed 27 November 2002, which is being treated as a Petition to Withdraw Holding of Abandonment under 37 CFR 1.181.

BACKGROUND

On 09 February 1999, applicants filed international application no. PCT/NO99/00043 which claimed a priority date of 09 February 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 August 1999. A proper Demand was filed with for International Preliminary Examination prior to the 19th month from the earliest claimed priority date. Accordingly, the thirty-month time period for submitting the requisite basic national fee in the United States of America was extended to expire 30 months from the priority date, i.e. 09 August 2000.

On 04 August 2000, applicants filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee of \$840, a copy of the international application, and a preliminary amendment.

On 23 August 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e). The notification set a one-month time limit in which to respond.

On 22 January 2001, applicants filed "Completion of Filing Requirements" which included a declaration and power of attorney executed by: Arild Follestad; Vidar Almquist; Harri Hokkanen and Marit Palmqvist on behalf of deceased inventor, Ulf Palmqvist.

On 27 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 23 August 2000 within the time period set therein.

On 27 November 2002, applicants filed "Petition to Reinstate Application."

DISCUSSION

A. Petition to Withdraw Holding of Abandonment

A proper response to the Notice of Missing Requirements mailed 23 August 2000 was due by 23 September 2000. On 22 January 2001, applicants filed "Completion of Filing Requirements" which was accompanied by an executed declaration. A review of the application file reveals that the declaration originally filed 22 January 2001 is located therein, therefore, the Notification of Abandonment (PCT/DO/EO/909) dated 27 March 2001 was mailed in error.

Applicant's Deposit Account No. 50-0548 has been charged a four-month extension of time fee (\$1390), as authorized.

B. Petition under 37 CFR 1.42.

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 22 January 2001 was executed by Marit Palmqvist for deceased inventor, Ulf Palmqvist. However, the declaration does not state that the relationship of Marit Palmqvist to the deceased inventor. Absent a statement that the signing heir is the sole heir or legal representative (executor) of the deceased inventor, the declaration cannot be accepted under 37 CFR 1.42.

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall

also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the residence, citizenship, and post office address of the deceased inventor, the declaration must also provide this information (residence, citizenship, and post office address) for the signing heir. The declaration filed on 22 January 2001 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the heir or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

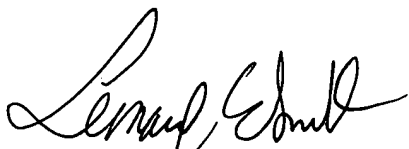
CONCLUSION

The petition to withdraw holding of abandonment under 37 CFR 1.181 is GRANTED, and the Notification of Abandonment (PCT/DO/EO/909) dated 01 August 2001 is hereby VACATED.

The request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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